

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Rolf W. Reisgies

Title: MODULAR MILKING PARLOR
AND TRANSPORT SYSTEM

Appl. No.: 10/643,521

Filing Date: 8/19/2003

Examiner: Kimberly S. Smith

Art Unit: 3644

Confirmation Number: 4464

APPELLANT'S REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Smith:

This communication is a reply brief to the Examiner's answer, dated January 10, 2007, and drafted in response to Appellant's Appeal Brief. This communication complies with 37 C.F.R. 41.41.

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paul S. Hunter for Appellant

Appellant's Reply to Examiner's Answer

This reply adopts the Examiner's heading notations for clarity. Appellant is responding to a number of issues raised in the Examiner's Answer, and has omitted those headings where Appellant deems that no reply is necessary, relying on the statements of record for the response.

(5) Summary of Claimed Subject Matter

The Examiner alleges that the Brief is deficient with respect to claims 11 and 12, because the claims do not meet the third prong of the three-prong analysis to determine if a claim properly invokes 35 U.S.C. § 112, sixth paragraph. (Examiner's Answer, page 2.) The Examiner states that the third prong of the analysis requires that the phrase, "means for" or "step for," must not be modified by sufficient structure, material or acts for achieving the specified function. *Id.* The Examiner further alleges that in both of claims 11 and 12, the "means for adjustably mounting the wheels to the carriage" has further been modified by the act "so that the wheels can be moved up and down." *Id.*

The Examiner Has Failed to Meet The Burden Under M.P.E.P § 2181

The Examiner states that the Appellant did not invoke 35 U.S.C. § 112, sixth paragraph, during the prosecution of the instant application. *Id.* However, likewise, the Examiner has never taken issue with the standard means plus function language used by the Appellant, and in doing so, failed to meet the burden set forth in M.P.E.P. § 2181:

If a claim limitation does include the phrase "means for" or "step for," that is, the first prong of the 3-prong analysis is met, but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office Action explaining the reason why a claim limitation which uses the phrase "means for" or "step for" is not being treated under 35 U.S.C. 112, sixth paragraph.

(Emphasis added).

In the first substantive Office Action (June 21, 2004), the Examiner specifically pointed to alleged structure in Ferris (U.S. Patent No. 3,019,763), to show "means for raising and lowering the platform to the ground for lessening the climb of the cows to the unit." (6/21/04 Office Action, section 4.) The Examiner continues, in the next sentence of the same Office Action, to discuss the Ferris

reference as not teaching “the wheels being adjustably mounted so as to raise and lower with respect to the carriage body.” *Id.* With this acknowledgement of the claim language, and the claim language specifically reciting “means for” language, the Examiner failed to put the Appellant on notice that the standard “means for” recitation by the Appellant would not invoke 35 U.S.C. § 112, sixth paragraph. This clearly has the effect of leaving the Appellant with the impression that the recited claim language properly invoked 35 U.S.C. § 112, sixth paragraph.

Appellant has included claims 11 and 12 for review by the Appeals Board as those claims are under a final rejection, and according to M.P.E.P. § 1205.02, the Appeal Brief must contain a summary of all claims’ subject matter for review separately arguing every means plus function claim.

Even If The Examiner Had Met The Burden, The Showing Would Have Failed

Assuming *arguendo* that the Examiner had alleged, at the proper time, that claims 11 and 12 failed to meet the criteria for a means-plus-function claim, Appellant would have traversed asserting that the claims do properly invoke 35 U.S.C. § 112, sixth paragraph. According to M.P.E.P. § 2181, the third prong of a determination whether a claim limitation invokes 35 U.S.C. § 112, sixth paragraph, states, “the phrase ‘means for’ or ‘step for’ must not be modified by sufficient structure, material or acts for achieving the specified function.” The phrase that the Examiner now takes issue with in claims 11 and 12 recites “having a carriage body and means for adjustably mounting wheels to the carriage body so that the wheels can be moved up and down with respect to the carriage body.” Appellant respectfully submits that this recitation complies with all three prongs of the three-prong analysis under 35 U.S.C. § 112, sixth paragraph.

M.P.E.P. § 2181(I) sets forth the requirements for proper invocation of 35 U.S.C. § 112, sixth paragraph:

A claim limitation will be presumed to invoke 35 U.S.C. § 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for” or “step for;”
- (B) the “means for” or “step for” must be modified by functional language; and
- (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function.

With regard to prong (A), there is no question that the claims meet the requirement, as “means for” is clearly recited in each of claims 11 and 12, the “means” being “adjustably mounting wheels to the carriage body.”

With regard to prong (B), there is also functional language as required. The functional language being “so that the wheels can be moved up and down with respect to the carriage body.”

With regard to prong (C), there is no further structure, material, or acts for achieving the specified function. In a means plus function claim, there should be a means and a function for achieving those means. M.P.E.P. § 2181 exemplifies a number of means plus function claims as having the structure: X means for function Y. Appellant has chosen to recite the claims as “means for adjustably mounting wheels to the carriage body so that the wheels can be moved up and down with respect to the carriage body.” Hence, the means are the adjustable mounting of the wheels to the carriage body, and the function is so that the wheels can be moved up and down. There is no further discussion in the claim of what the means are or how to perform the function.

M.P.E.P. § 2181(I) illustrates numerous examples where the third prong of the analysis was not met when standard means-plus-function language was used in a given claim. In each of the examples, the proffered claim did not meet the third-prong requirements because sufficient structure, material, or acts were *specified in the claim*, contrary to the instant application where no further direction is provided by the claim. For example, in *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 54 USPQ2d 1449 (Fed. Cir. 2000), the court held that the word “baffle” in the phrase “baffle means” imparts structure, and the claim recites the structure of the baffle. Therefore, the claim does not fall under 35 U.S.C. § 112, sixth paragraph. In *Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303-04, 50 USPQ2d 1429, 1435-36 (Fed. Cir. 1999), the court held that “positioning means for moving” did not invoke 35 U.S.C. § 112, sixth paragraph, because the claim provides a list of the structure of the underlying means and detailed recitation of the structure for performing the moving function removes this element from the purview of 35 U.S.C. § 112, sixth paragraph. In *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996), the court held that “perforation means...for tearing” did not invoke 35 U.S.C. § 112, sixth paragraph, because the claim describes the structure supporting the tearing function (i.e., the perforation). The claims currently under appeal do not recite further structure, material or acts to modify the function, unlike the provided examples, and, thus, the claims currently under appeal properly invoke 35 U.S.C. § 112, sixth paragraph.

Appellant submits that not only has the Examiner failed to meet the burden of showing that claims 11 and 12 do not invoke 35 U.S.C. § 112, sixth paragraph, but even if the issue had been proffered, claims 11 and 12 properly invoke 35 U.S.C. § 112, sixth paragraph. Appellant respectfully requests full consideration of the claims as means-plus-function claims under 35 U.S.C. § 112, sixth paragraph, during the instant appeal.

(9) Grounds of Rejection

In this section, the Examiner has merely restated the previous grounds for rejection. Appellant stands by the remarks of record in traversing the Examiner's rejection and adds the following to the discussion.

The Examiner again alleges that "Ferris further discloses a plurality of wheeled carriages having a carriage body (i.e., the axle mechanism), which is detachable from the milking parlor frame..." (Examiner's Reply, pages 3-4.) Appellant submits that this is *not* taught or suggested by Ferris. For clarity, Ferris is U.S. Patent No. 3,019,763 and Smith, *vide infra*, is U.S. Patent No. 4,250,836.

Claims 11 and 12 require "a plurality of wheeled carriages temporarily connected *to the milking parlor frame*," and Figure 4 of the instant application clearly shows wheeled carriages connected to the milking parlor frame. Appellant respectfully directs the Board's and the Examiner's attention to Figures 1, 2 and 4 of Ferris which show the axle being attached to the floor, i.e., bed, of the trailer. The axle is not attached to the frame of the milking stations. The frame of Ferris is the vertical pipes or rods 30 and the tube 37. Ferris, at Col. 3, lines 8 and 25. The wheels of Ferris are not connected to either the pipes, rods or tube. For at least this reason, Ferris fails to teach each and every element of the claims as currently recited.

However, Appellants recognize that the full rejection proffered by the Examiner is under 35 U.S.C. § 103(a) over Ferris in view of Smith. As discussed in the Appellant's Appeal Brief, page 14, Smith teaches a portable corral with no teaching or suggestion of a milking parlor frame. Hence, for at least this reason, Smith and Ferris, alone or in combination, fail to teach each and every element of the claims as currently recited. Therefore, for this reason and all the reasons in the Appellant's Appeal Brief, Appellants respectfully request that the Board reverse the Examiner's final rejection.

(10) Response to Argument

B-1. Rejection of Claims 11-15 and 17 Under 35 U.S.C. § 103(a) Based on Ferris in View of Smith.

Appellant directs the Board's attention to the above discussion of the invocation of 35 U.S.C. § 112, sixth paragraph. The Examiner failed to meet the burden of showing that the claims do not invoke 35 U.S.C. § 112, sixth paragraph, and the Appellant has proceeded throughout the prosecution as if the claims did invoke 35 U.S.C. § 112, sixth paragraph, as the first prong of the analysis is undoubtedly met. Appellant asserts that the Examiner has delayed asserting that 35 U.S.C. § 112, sixth paragraph, was not properly invoked, because when the claims are read in light of the specification and for what it fairly teaches of the means-plus-function language, the Examiner's arguments based upon Ferris and Smith must fail, as outlined in the Appeal Brief, pages 10-14.

In addition to failing as stated in the previous paragraph, the Examiner's continued rejection based upon Ferris and Smith must fail in other respects as well. In responding to the Appellant's Appeal Brief, the Examiner again alleges that the Appellant needs to show evidence to support the statement that Ferris does not disclose the carriage (i.e., axle of a semi-trailer) as being detachable from the semi-trailer milk house (Examiner's Answer, page 7). Appellant has already shown this. Appellant has stated on more than one occasion that claims in a patent application must be read in light of the specification. (See Appeal Brief, page 12; also Applicant's Response of June 13, 2006, page 9.) As such, the claims of a cited reference must be read in the context of that specification as well.

In the instant specification, a "carriage" is described to have a body 61, swiveling caster type wheels 73, attached to a jack 74. (Paragraph [0023].) "Temporarily connected" and "detachable" are used complementary with one another and describe how the carriages are used by being "mounted to the modular parlor" prior to transport, transporting the modular parlor into the parlor building in which it is installed, and "[o]nce the modular parlor 10 has been brought into the parlor building...[t]he carriages 60 are then detached from the modular parlor." (Paragraphs [0025] and [0026].)

Conversely, Ferris teaches a semi-trailer milking apparatus with an attached trailer axle for over the road use, to travel to a plurality of farms in a local area (Col. 1, lines 10-25). The stated purpose of this is that the "mobile milking room and milk house...enables an independent trained crew to come to each farm in an area to handle the milking more efficiently." (Col. 1, lines 15-18.) To remove the axle at each stop, because this is what the Examiner is suggesting by imputing the term detachable to the axle of a semi-trailer, would clearly defeat any suggestion of a quick and efficient milking operation

and allowance for travel to a plurality of farms. This is clearly not a purpose of the present invention, as the present invention is intended to be installed in a parlor building on a farm.

The instant application also makes a distinction between a truck and the milking parlor, a distinction not observed by the Examiner in alleging that Ferris is obviating of the presently claimed invention. The present specification teaches a milking parlor which is supportable on wheels for hand transport through a parlor building (paragraph 25). Also in paragraph 25, the Appellant has shown that a truck and the milking parlor are distinct items, i.e., “the truck [onto which the parlor was loaded at the factory] may be able to back up to a platform which extends into the dairy building where the parlor is to be installed, allowing the modular parlor 10 supported by the carriages 60 to be rolled off of the truck and directly onto the platform...” When reading the claims of the present application in light of the instant specification, it is clear that the present invention is not encompassing of a truck and semi-trailer milkhouse.

Ferris Does Not Teach A Plurality Of Wheeled Carriages.

The Examiner also alleges “that the Ferris reference does meet the claim limitation of *a plurality* of wheeled carriages, as more than one wheeled carriage is disclosed in the Ferris reference” (Examiner’s Answer, page 9). The Examiner states that “as seen in Figure 1 of Ferris, the side profile shows two wheels (17) thereby rendering obvious to one with skill in the art that Ferris also discloses a plurality of wheeled carriages.” *Id.* Appellant submits that this statement is undeniably wrong.

Figure 1 of Ferris illustrates two sets of wheels labeled with reference numeral 17. One pair of wheels, to the right in Figure 1, are wheels on a single axle of a semi-trailer. The other set of wheels, to the left in Figure 1, are the rear wheels of the truck. Hence, Figure 1 illustrates a trailer with only a single axle with wheels. Figure 2 of Ferris, a view of the rear of the semi-trailer, also shows four wheels (17) on a single axle. Hence, contrary to the Examiner’s assertion, there is not a single figure in the Ferris application that shows *a plurality* of wheeled carriages on the semi-trailer.

Smith Needs To Fill The Voids Of Ferris

The Examiner also takes issue with Appellant’s argument that the Smith reference does not individually teach the wheeled carriages. Appellant has argued the Smith reference individually and in combination with Ferris, for in order to establish obviousness, each element of a claim must be obvious over both references in either their joint or individual capacities as references. 35 U.S.C. § 103(a) and M.P.E.P. § 2143. Appellant has already shown in Appellant’s Brief that Ferris fails to teach “a plurality of wheeled carriages temporarily connected to the milking parlor frame, each carriage being

detachable from the milking parlor frame," and as such, those limitations must be met by Smith in order for the reference(s) to teach each and every limitation of the claimed invention as is required for a proper rejection under 35 U.S.C. § 103(a). See M.P.E.P. § 2143. Appellant stands by the remarks of record regarding the failure of Smith to fill the voids of Ferris.

B-2. Response to Examiner's Answer to Appellant's Arguments that the Suggestion to Modify Would Render the Ferris and Smith Devices to be Unsuitable for Their Intended Purpose.

The Examiner states that the "Ferris reference was not modified to provide for the feature of being detachably connected and it has been maintained that it is an obvious function of the Ferris device." (Examiner's Answer, page 10.) Appellant is unsure of the spurious use of the term "obvious function." If the Examiner wishes to provide a *prima facie* case of obviousness that the axle of a semi-trailer is detachable within the context of both Ferris and the instant application, Appellant respectfully requests that the Examiner provide the requisite teaching or suggestion in either Ferris alone, or in Ferris in combination with, an as yet unidentified reference of the "obviousness" of the detachable character of a semi-trailer axle.

Appellant has not disputed that the axle may be removed from a trailer. The Appellant has argued that one of skill in the art would not consider an axle of a semi-trailer to be detachably connected, especially in light of the teachings of Ferris regarding the intended uses discussed above. Appellant has also stated and maintains that a semi-truck driver would never take to the open road with a trailer having detachably connected wheels. Again, Appellant asserts that the claims must be read in light of the specification. Appellant is not asking that limitations be read from the specification into the claims, however, the scope of the claims must be commensurate in scope with what is disclosed in the specification. And, here, a semi-trailer is not within the disclosure of the instant specification, and, likewise, the modular milking parlor of the presently claimed invention is not within the disclosure of Ferris.

B-3. Response to Examiner's Answer to Appellant's Arguments that Ferris in View of Smith Should be Reversed Because Ferris and Smith are Directed to Non-Analogous Art.

Appellant stands by the remarks of record.

C-1. Response to Examiner's Answer to Appellant's Arguments Regarding Ferris in View of Smith in View of van der Lely Do Not Teach or Suggest at Least One Limitation of Each of Claims 16 and 18.

In responding to the Appellant's arguments, the Examiner states that Appellant has not addressed the van der Lely reference for what it was relied upon to teach. The van der Lely reference is relied upon for a teaching of an automatic teat cup cluster detacher. Dependent claims 16 and 18 recite, in part, elements of an automatic teat cup cluster detacher. Again, Appellant need not reach the point for which van der Lely was relied upon to teach because Appellant definitively showed that van der Lely fails in all respects to fill the voids left by Ferris in view of Smith with regard to the independent claims from which claims 16 and 18 depend -- those voids being succinctly put forth in Appellant's previous responses and Appeal Brief. If the independent claim is patentable over the cited art, the dependent claim, by definition, is also patentable.

Request

For the above reasons, Appellant respectfully submits to the Appeal Board that the rejections should be reversed and the application allowed to move forward to issuance.

It is believed that no fees are due for this Reply Brief. Nonetheless, the Commissioner is hereby authorized to charge any fees which may be required for this Reply Brief, or to credit any overpayment, to Deposit Account No. 50-2350.

Respectfully submitted,

By 

Date February 21, 2007

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4292
Facsimile: (608) 258-4258

Paul S. Hunter
Attorney for Appellant
Registration No. 44,787